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OFFICE OF PETITIONS

In re Application of
Doucas; Evans and Trono
Application No. 09/990,255
Filed: November 20, 2001
Attorney Docket No. SALK2150-1
(088802-4901)

: DECISION REFUSING STATUS
: UNDER 37 CFR 1.47(a)

:

This is in response to the communication filed October 16, 2002, which, in view of the statement that "Dr. Doucas has been an uncooperative inventor" and in a light most favorable to applicant, is being treated as a petition under 37 CFR 1.47(a).

The petition is dismissed.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the nonsigning inventor. **FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.** Any extensions of time will be governed by 37 CFR 1.136(a).

The above-identified application was filed on November 20, 2001 with a declaration executed by joint inventors Ronald M. Evans and Didier Trono, but not by joint inventor Vassilis Doucas. Accordingly, on March 12, 2002, a "Notice to File Missing Parts of Application" was mailed, requiring an executed oath or declaration by joint inventor Doucas and a surcharge. The Notice additionally required compliance with the requirements of 37 CFR 1.821-1.825.

In response to the requirement for an executed oath or declaration by joint inventor Doucas, on October 16, 2002, the instant communication which is being treated as a petition under 37 CFR 1.47(a), bearing a certificate of mailing date of October 11,

2002, along with copies of a petition under 37 CFR 1.48(a) filed in parent Application No. 08/975,272, an extension of time fee of \$980 for a five month extension of time, and authorization to charge any additional fees required, was filed. The petition of October 16, 2002 also states that the request to comply with the requirements of 37 CFR 1.821-1.825 has been issued in error since there are no sequences in the application, nor was a sequence requirement issued in the parent application.

Initially, to address the sequence requirement made in the Notice of March 12, 2002, petitioner is correct that the application does not contain a sequence listing. Therefore, this requirement was made in error and is hereby withdrawn.

Next, petitioner should note that it is immaterial in this case that a determination first be made in the parent application as to the correct inventorship, since the instant divisional application was submitted with a declaration naming all the inventors and executed by two of the three joint inventors. In a nonprovisional application filed under 35 U.S.C. 111(a), where the first-filed executed oath or declaration was filed on or after December 1, 1997 and names the correct inventors, a petition under 37 CFR 1.48 is not required. *See* 37 CFR 1.48(f)(1). Further, an available remedy to obtain correction of inventorship where waiver of a required statement is not available to correct the inventorship in a particular application is to refile the application naming the correct inventive entity. Benefit of the parent application's filing date would be available under 35 U.S.C. 120 provided there is at least one inventor overlap between the two applications. Therefore, the fact that a petition to correct inventorship in the parent application was either not decided, not decided prior to issuance, or decided adversely does not affect the inventorship in the instant application, since the first-filed executed oath or declaration set the inventive entity herein.

As to the petition under 37 CFR 1.47(a), a grantable petition under 37 CFR 1.47(a) requires: (1) proof that the nonsigning inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the nonsigning inventor. Applicant lacks items (1) and (4) set forth above.

As to item (1), rule 47 applicant must demonstrate with documented evidence that an inventor refuses to join in the application after having been presented with the application papers (specification, claims, drawings and oath or declaration). There

is no indication as to whether joint inventor Vassilis Doucas was ever presented with a copy of the complete application papers for the instant nonprovisional application. Before a refusal can be alleged, it must be demonstrated that a copy of the application papers for the instant nonprovisional application was presented to the nonsigning inventor. If joint inventor Doucas was not presented with a copy of the application papers for the instant nonprovisional application, then joint inventor Doucas could not attest that he has "reviewed and understands the application papers" and could not execute the declaration he was requested to sign. Did joint inventor Doucas receive a copy of the application papers? Unless petitioner can show that a copy of the application papers was presented to joint inventor Doucas, then petitioner will have to mail a copy of the complete application papers (specification, claims and drawings) to the last known address of joint inventor Doucas, return receipt requested. A cover letter of instructions should accompany the mailing of the application papers setting a deadline or a statement that no response will constitute a refusal. This sort of ultimatum lends support to a finding of refusal by conduct. **The proof of the pertinent events should be made by a statement of someone with firsthand knowledge of the events and should include documentary evidence, such as certified mail return receipt, cover letter of instructions, telegram, etc.** See MPEP 409.03(d).

Where there is an express or oral refusal, that fact, along with the time and place of the refusal, must be stated in an affidavit or declaration **by the party to whom the refusal was made.** Where there is a written refusal, a copy of the document(s) evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the rule 47 applicant that an omitted inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in an affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence must be submitted.

Whenever an omitted inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

As to item (4), a statement of the inventor's last known address is missing and is required.

In order to expedite consideration, petitioner may wish to submit the renewed petition under 37 CFR 1.47(a) by facsimile transmission to the telephone number indicated below and to the attention of the undersigned.

As authorized, the \$130 fee for the instant petition under 37 CFR 1.47(a) and the \$65 surcharge fee will be charged to petitioner's Deposit Account No. 50-0872.

Further correspondence with respect to this matter should be addressed as follows:

By mail: U.S. Patent and Trademark Office
 P.O. Box 2327
 Mail Stop DAC
 Arlington, VA 22202

OR

Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
 Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
 2201 South Clark Place
 Arlington, VA 22202

Any questions concerning this matter may be directed to the undersigned at (703) 305-8680.


Frances Hicks
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy


Conferree: Brian Hearn